

MAIL STOP APPEAL BRIEF-PATENTS
PATENTS
8023-1013

IN THE U.S. PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of	Appeal No.
Yoshiyuki MIYAMOTO	Conf. 2990
Application No. 10/025,473	Group 1751
Filed December 26, 2001	Examiner Mark T. Kopec
SUPERCONDUCTING MATERIAL AND METHOD FOR PRODUCING THE SAME	

REPLY BRIEF

MAY IT PLEASE YOUR HONORS:

The Examiner's Answer at pp. 6-8 argues that 35 USC 112, ¶1 includes requirements not subsumed by 35 USC §101 - a point not in dispute. The impropriety of the rejection on appeal resides instead in the fact that the only criticism of the invention found therein is skepticism as to whether the claimed materials possess superconductive properties, a concern that is entirely subsumed by 35 USC §101, and one that on the present record has already been expressly resolved in appellant's favor.

In apparent recognition of this, the Examiner's Answer, beginning in the middle of page 9 and continuing to page 10, seeks to criticize for the first time the disclosure of the present application as it relates to a variety of process parameters for making the claimed materials. A series of purely speculative questions are posed for the first time at page 10,

and a reference of record but never previously relied upon (describing an unrelated polymerization technique) is cited in purported support of these newly-stated concerns.

Whereas the newly-expressed concerns focus solely on the disclosure at page 7, lines 7-11 of the present specification, the additional detailed disclosure pertaining to how to make the claimed materials that appears for example at page 3, line 23 through page 4, line 28 and page 7, lines 1-6 (which latter passage in turn references a prior literature article describing production of C₂₀ fullerenes) is ignored.

Aside from the obvious procedural impropriety of the above approach and its lack of evidentiary support, the record is clear that this is not the rejection on appeal. This is shown in the paragraph bridging pages 5-6 of the rejection on appeal (the July 1, 2004 Official Action), where the Examiner stated that:

"[i]n order to overcome the above rejection, applicant should provide conclusive evidence that the claimed materials (produced according to the specification disclosure) possess superconductive properties. See 37 CFR 1.93 and MPEP 608.03."

Plainly, the call for evidence that the claimed materials possess superconductive properties does not question the adequacy of the disclosed process to produce the claimed materials. It instead questions the accuracy of the description of those materials as possessing such properties. The Examiner's newfound and unfounded criticism of certain aspects

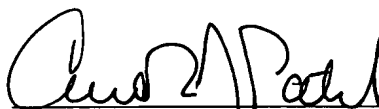
of the disclosed process parameters is therefore neither the rejection on appeal nor does it serve to rehabilitate the same.

As regards the separately argued independent patentability of claims 4-8, the Examiner's Answer contends only that "the disclosure relating to these claims (page 7, lines 14-27 of the specification) does not cure the deficiencies discussed above." The final rejection is therefore plainly further unsustainable as regards claims 4-8, as the Examiner's Answer in defense of that rejection consists of a conclusory allegation that refers in an entirely unexplained way to the untimely, insufficient and irrelevant rationale put forth for the first time in the Examiner's Answer.

The above discussion is believed to underscore the impropriety of the rejection on appeal, and that it should be reversed. Such action is accordingly respectfully requested.

Respectfully submitted,

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